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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,138	11/25/2003	Robert P. Loce	A3568-US-NP XERZ 2 01656	2082
62095 7590 11/26/2007 FAY SHARPE / XEROX - ROCHESTER 1100 SUPERIOR AVE. SUITE 700 CLEVELAND, OH 44114			EXAMINER DANG, DUY M	
			ART UNIT 2624	PAPER NUMBER
			MAIL DATE 11/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/721,138

Applicant(s)

LOCE ET AL.

Examiner

Duy M. Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. Applicant's request for reconsideration to decision on petition acceptance of color drawings filed on October 24, 2007 is acknowledged and has been forwarded to the TC QAS group for consideration.

### ***Amendments***

2. Applicant's amendment filed on September 14, 2007 has been entered and made of record.

### ***Response to Arguments***

3. Applicant's arguments filed on September 14, 2007 have been fully considered but they are not persuasive.

It is noted that applicant's remarks focused on the three-element combination (1)-(3), see page 14, and concluded that both patents '522 and '068 do not teach or suggest the so-called three-element combination, see page 15. In response, the examiner would like to offer the following remarks:

(a)As to element (1) that of "polychromatic source image", applicant is reminded that the examiner is entitled to give the broadest reasonable interpretation to the language of the claims. So the examiner considers "source images" in claim 1 of both patents '522 and 068 to be Applicant's "polychromatic source image" within the broad meaning of the term. The examiner is not limited to applicant's definition which is not specifically set forth in the claims. In re Tanaka et al., 193 USPQ, (CCPA) 1977.

(b)As to element (2) that of “first and second separation images presenting the polychromatic source image”, the “plurality source images” in claim 1 of both patents ‘522 and ‘068 do have at least two separation images so that the “composite image” in claim 1 of both patents ‘522 and ‘068 can be rendered or generated. Therefore, the “plurality of source images” in claim 1 of both patents ‘522 and ‘068 in view of rational set forth at (a) above correspond to the so called “first and second separation images presenting the polychromatic source image.”

(c)As to element (3) that of “recovering the encoded separation images” and “presenting the polychromatic source image as a normalized color image”, the “recovering the encoded separation images” is met by the “recovering the encoded source image from the rendered composite image” recited at lines 7-8 of claim 1 of patent ‘522 and lines 9-10 of claim 1 of patent ‘068. As to the “presenting the polychromatic source image as a normalized color image”, it is not recited in instant claims 1 and 11. At best understood, the recitation of “polychromatic source image is made distinguishable as a normalized color image” cited in the last five lines of instant claim 1 is a recovered image version from the encoded source image and this is satisfied by the “recovered source images are made distinguishable” set forth at lines 8-9 of claim 1 of patent ‘522 and line 11 (or column 31 line 1) of claim 1 of patent ‘068. While the claimed “normalized color image” might be silent in both claims 1s of the patents ‘522 and ‘068, both claims 1s of the patents ‘522 and ‘068 do teach a recovered source images as pointed out above and the claimed “normalized color image” is also a recovered image version. Thus, claims 1s of both patents ‘522 and ‘068 do teach claimed “normalized color image” in that regard.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 7,136,522 (referred as the patent '522 hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons as follows:

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Anticipation is "the ultimate or epitome of obviousness" (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

The advanced statements as set forth in paragraph 3 above are incorporated hereinafter.

As to claim 1 as a representative claim, this claim 1 of the instant application is a broader recitation of the invention and the claim 1 of the patent '522 covers the equivalent subject matter as that of claim 1 of the instant application. Specifically, each limitation of claim 1 of the instant

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application is set forth in claim 1 of the patent '522. For example, patented claim 1 teaches:

*“receiving...composite image”* in lines 1-4; *“rendering the composite image...colorants”* in lines 5-6; and *“recovering...color image”* in lines 7-15. While the patented claim 1 includes additional limitations not set forth in claim 1 of the instant application, the use of transitional term “comprising” in the instant claim 1 fails to preclude the possibility of additional elements.

Therefore, claim 1 of the instant application fails to define an invention that is patentably distinct from claim 1 of the patent '522. Likewise, claim 11 of the instant application fails to define an invention that is patentably distinct from claim 12 of the patent '522.

Each of dependent claims 2-10 and 12-35 of the instant application is also defined by the claims 2-11 and 13-19 of the patent '522 so that these claims 2-10 and 12-35 of the instant applicant also fail to define a patentably distinct invention.

6. Claims 1-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,155,068 (referred as the patent '068 hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons as follows:

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Anticipation is “the ultimate or epitome of

obviousness” (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

The advanced statements as set forth in paragraph 3 above are incorporated hereinafter.

As to claim 1 as a representative claim, this claim 1 of the instant application is a broader recitation of the invention and the claim 1 of the patent ‘068 covers the equivalent subject matter as that of claim 1 of the instant application. Specifically, each limitation of claim 1 of the instant application is set forth in claim 1 of the patent ‘068. For example, patented claim 1 teaches: “*receiving...composite image*” in lines 1-6; “*rendering the composite image...colorants*” in lines 7-8; and “*recovering...color image*” in lines 9-14. While the patented claim 1 includes additional limitations not set forth in claim 1 of the instant application, the use of transitional term “comprising” in the instant claim 1 fails to preclude the possibility of additional elements. Therefore, claim 1 of the instant application fails to define an invention that is patentably distinct from claim 1 of the patent ‘068. Likewise, claim 11 of the instant application fails to define an invention that is patentably distinct from claim 12 of the patent ‘068.

Each of dependent claims 2-10 and 12-35 of the instant application is also defined by the claims 2-11 and 13-18 of the patent ‘068 so that these claims 2-10 and 12-35 of the instant applicant also fail to define a patentably distinct invention.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M. Dang whose telephone number is 571-272-7389. The examiner can normally be reached on Monday to Friday from 6:00AM to 2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dmd  
11/07



**DUY M. DANG**  
**PRIMARY EXAMINER**